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Elliott D. Light

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EXAMINER

ZURITA, JAMES H

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                     |  |
|------------------------------|--------------------------------------|-------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/559,778 | <b>Applicant(s)</b><br>LIGHT ET AL. |  |
|                              | <b>Examiner</b><br>JAMES ZURITA      | <b>Art Unit</b><br>3625             |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on 02 January 2009.

2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 80-86, 89-98, 101-110 and 113-116 is/are pending in the application.

    4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 80-86, 89-98, 101-110, 113-116 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All    b) ☐ Some \*    c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
    Paper No(s)/Mail Date \_\_\_\_\_.

4) ☐ Interview Summary (PTO-413)  
    Paper No(s)/Mail Date \_\_\_\_\_.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Amendment*

On 01/02/2009, Applicant amended claims 80, 92, 104 and 116.

Claims 80-86, 89-98, 101-110 and 113-116 are pending and will be examined.

Claims 80, 92, 104 and 116 are independent.

### *Response to Arguments*

Applicant's arguments filed 01/02/2009 have been fully considered but they are not persuasive.

Applicant's footnote, page 12, first appeared on 06/04/2008 (page 9), and was repeated verbatim on 09/02/08 (also page 9), as is no longer applicable.

As to rejection under 35 USC 112, applicant avoids reference 248 and argues:

Applicants note that the specification defines the term on page 14, lines 18-20 ("the data subject is presented with a buy decision... the data subject can elect to buy the item, change the data subject's information and buy the item, or cancel the transaction")...

Applicant argues that a data subject can elect one of three options: (a) buy the item, (b) change subject's information and buy the item or (c) cancel the transaction.

Applicant argues, however,

Notwithstanding this definition, in the present Office Action, the Examiner has interpreted the term "buy decision" so broadly as to be inconsistent with the definition which Applicants are using as their own lexicographers.

Respectfully, these comments are not definitions. While applicant may be his or her own lexicographer, a term may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). **Two** options is not the same as **three** options.

Applicant argues,

Applicants submit that, because the amendment with respect to the term "buy decision" does no more than to repeat the definition which Applicants provided for that term in the specification, this amendment does not change the scope of the claims.

In response Applicant has not provided a "...specific definition..." Applicant's definition of reference 248 and its interpretation has shifted during prosecution. For example:

On 07/21/2005, page 12, applicant argued that decision block **248** has two options, YES and NO.

The purchase query is shown in, for example, Fig. 2C in conjunction with item 248, present offer, which is a purchase query presented to the data subject. The purchase reply is shown, for example, in conjunction with item 248, where the data subject decides whether to buy the item, and selects either yes or no, which constitute the purchase reply. Regarding claims reciting summaries, these claims have been canceled.

On 09/04/2008, applicant admitted that purchase reply is a buy decision:

In response to the Examiner's apparent assertion that "purchase query" and "purchase reply" are not defined in the specification (see Advisory Action, p. 2), Applicants have replaced those terms with "**buy decision**" and "election to purchase the item," respectively. It appears to Applicants that the Examiner has taken the position that the present application does not explicitly define "**buy decision**" (see Advisory Action, p. 2). In response, Applicants respectfully disagree and refer the Examiner to page 14, lines 17-20, from which Applicants quoted in their response to the last Office Action (emphasis added here):

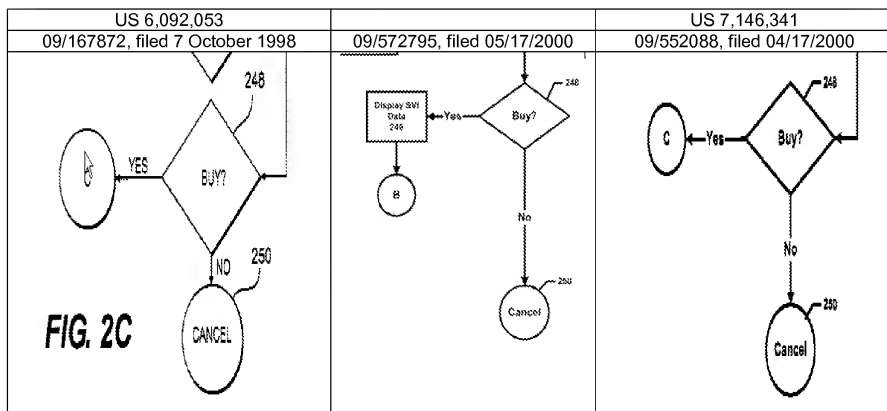
[citation omitted]

Applicants submit that the foregoing quote does indeed provide a definition for "**buy decision**," such that Applicants have acted as their own lexicographer. The Examiner is not entitled to ignore this kind of definition, and thus cannot give an interpretation so broad as to be inconsistent with the way Applicants use the term.

Further, that a person skilled in the art might realize from reading the disclosure that such a particular definition (as now argued) is a possible definition **is not** a sufficient indication to that person that that particular definition is part of Applicant's invention as originally filed. Claims yet unpatented are to be given the broadest

reasonable interpretation consistent with the specification during the examination of a patent application. In re Prater, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969).

In related applications, Fig. 2C, reference 248 shows **two options**. For example:



As to rejection under 35 USC 102, applicant argues,

As previously noted, the present application defines "**buy decision**" on page 14, lines 17-20 (emphasis added):

[citation omitted]

While Applicants disagree with the Examiner's overly broad interpretation of "**buy decision**," the amendments to the independent claims insert Applicants' definition from the specification. Applicants do not believe this amendment to be necessary, since Applicants have acted as their own lexicographer. Applicants also do not believe that this amendment changes the scope of the claims, because the definition is merely the one which Applicants provided in the specification. In any event, each of the independent claims now specifies that the **buy decision** "present[s] a choice between purchasing [an] item, changing the purchasing information [associated with a data subject/purchaser], and declining to purchase the item" (emphasis added).

Paltenghe lacks the "**buy decision**" of the present application because Paltenghe does not teach the option to change the data subject's information. Even if the "consumer has the opportunity to request a purchase" or "can elect to purchase, as in paragraph 0061" (Office Action p. 3), Paltenghe does not teach presenting the data subject with the option to modify his or her information after receiving an offer from the merchant.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 80-86, 89-98, 101-110 and 113-116 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 80-86, 89-98, 101-110 and 113-116 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

**Two** options is not the same as **three** options. See Fig. 2C, reference 248. The specifications describe three options:

37        Once the data subject enters a correct passphrase or if there was no browser identifier for the  
38        data subject, the data subject is presented with a buy decision 248. The data subject has several options  
39        available at this step: the data subject can elect to buy the item, change the data subject's information  
40        and buy the item, or cancel the transaction. If the data subject elects to change the data subject's  
41        information, the data subject must still decide to either buy the item or cancel the transaction after  
42        changing the information. If the data subject declines to purchase the item, then the transaction is  
43        canceled 250, and the information held in the temporary data structure is deleted, the dialogue ends and  
44        the transaction is terminated 250.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 80-86, 89-98, 101-110 and 113-116 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Two** options is not the same as **three** options. See Fig. 2C, reference 248.

Claims 80, 92, 104 and 116 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims were amended to accommodate the option ...in response to an election to purchase the item.... The claims are rendered indefinite since it is not possible to determine the scope of the claim as requiring:

Choice of one option(YES or NO)

Choice of two options (reference 248, YES / NO)

Choice of three options claimed (a) a subject can elect to buy the item, (b) change the data subject's information and buy an item or (b) cancel the operation. For purposes of this examination, examiner will give the term "...buy decision..." its broadest reasonable interpretation and consider that the particular condition is satisfied if one of the limitations is met. Prior art is interpreted to meet the claimed limitations where prior includes a customer decision to buy, which may be evidenced by billing consumers for purchases, and by a customer requesting to make a purchase.

***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 80, 81, 92, 93, 95, 104, 105, as interpreted, are rejected under 35 U.S.C. 102(e) as being anticipated Paltenghe (US PG-PUB 2001/0011250A1).

For purposes of Examination, Data subject is interpreted as a consumer/customer, data recipient is interpreted as a merchant. Data subject registration is interpreted as having a consumer's information retained on a data repository.

Buy decision is the consumer's decision to buy, as evidenced by billing for purchases, and by a customer requesting to make a purchase.

**As per claim 80**, Paltenghe discloses method(s) for allowing

- a data subject (consumer, reference 25)
- to purchase (see, for example, at least paragraph 0061 and references to consumer purchases)
- an item (see, for example, at least references to goods, paragraph 0029)
- from a data recipient [merchant] (merchants and service providers, reference 27)
- over a computer network (Internet, for example, paragraph 6, network, paragraph 0045), comprising:
  - (a) **receiving**, from a data subject network communication device (see at least paragraph 0010)
  - an offer associated with the item and with the data recipient [merchant] (see, for example, merchant offers, paragraph 0062; they are associated with merchants) and



- a message (see, for example, message(s), as in paragraph 0049, communication messages to/from consumers and Information Bank 23) including a network communication device software identifier (see, for example, at least paragraph 0007 and references to cookies),
  - offer and the message being received at a data repository computer (see, for example, specific merchant offers received at Information Bank, forwarded to specific consumers, the offer associated with a specific merchant being accepted by the specific consumer; then the acceptance of that offer sent to the Information Bank as message 29 from consumer 25 to Information Bank 23, as in Fig. 1);
  - the offer originating from the data subject [consumer] accessing a web page of the recipient (see, for example, a customer browsing merchant sites, as in paragraph 0068; see also paragraph 0007, which discusses browsing web sites).
- (b) **determining** whether the data subject is registered (see, for example, references to service account, where consumer information may be stored for future use, as in applicant's disclosures, page 26, lines 26-27);
- (c) **determining** whether the data recipient [merchant] is authorized (see, for example, at least references to authorized merchants, as in paragraph 0010);
- (d) [if the data subject is registered and the data recipient [merchant] is authorized], **retrieving** purchasing information associated with the data subject from a database in the data repository computer (see, for example, at least paragraphs 0014 and 0071, concerning purchasing information such as credit card);

(e) sending a buy decision to the data subject network communication device (see, for example, at least paragraphs 0026, consumers can search shop and negotiate, and 0061, the information bank sends merchant's offer to a consumer) ; and

(f) in response to a buy decision [aka purchase reply] received from the data subject network communication device, sending purchase transaction information to the data recipient [merchant]. See, for example, at least paragraph 0029, concerning billing consumers for purchases. See also paragraph 0061, which discloses that customers request to purchase.

**As per claim 81**, Paltenghe discloses that determining whether the data subject [consumer] is registered includes determining whether the network communication device software identifier matches an entry in the database (see, for example, at least references to cookies, as in paragraph 0007).

Claim 92 is rejected on the same grounds as claim 80.

Claim 93 is rejected on the same grounds as claim 81.

Claim 104 is rejected on the same grounds as claim 80.

Claim 105 is rejected on the same grounds as claim 81.

Claim 116 is rejected on the same grounds as claim 80.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 82-86, 89-91, 94, 96-98, 101-103, 106-110, 113-115, as interpreted, are rejected under 35 U.S.C. 103(a) as being unpatentable over Paltenghe in view of Meyers (US 6,915,271).

***As per claim 82*** Palthenge ***does not*** specifically disclose that an offer includes a data recipient [merchant] identifier, an item price, a data recipient [merchant] digital signature, a final price indicator and a transaction number. Meyer discloses that the offer includes a data recipient [merchant] identifier (see, for example, references to URL, as in Col. 39, lines 29-55), an item price (see, for example, at least Col. 41, line 66-Col. 42, line 25), a data recipient [merchant] digital signature (see at least Col. 47, line 48-Col. 48, line 4), a final price indicator and a transaction number (see, for example, at least Col. 41, line 66-Col. 42, line 25, total price, transaction ID number).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Palthenge and Meyer to disclose that an offer includes a data recipient [merchant] identifier, an item price, a data recipient [merchant] digital signature, a final price indicator and a transaction number.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Palthenge and Meyer to disclose that an offer includes a data recipient [merchant] identifier, an item price, a data recipient [merchant] digital signature, a final price indicator and a transaction number for the obvious reason that the details may be used for tracking and analysis on a regular basis, possibly identifying suspicious patterns.

**As per claim 83**, Paltenghe discloses that purchasing information associated with the data subject [consumer] includes credit card information and shipping information, the shipping information including a shipping address and a preferred shipping method (see, for example, at least paragraphs 0071, 0072).

**As per claim 84**, Palthenge **does not** specifically disclose determining whether the credit card information is accepted by the data recipient [merchant]. Meyer discloses determining whether the credit card information is accepted by data recipient [merchant] (see, for example, at least Col. 41, lines 22-40, Col. 50, lines 38-52).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Palthenge and Meyers to disclose determining whether the credit card information is accepted by the data recipient [merchant].

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Palthenge and Meyers to disclose determining whether the credit card information is accepted by the data recipient [merchant] for the obvious reason that a merchant may wish to get paid for purchases.

**As per claim 85**, Paltenghe discloses obtaining a new price from the data recipient [merchant] based on the shipping address and the preferred shipping method; and setting the item price equal to the new price (see, for example, at least paragraph 0072).

**As per claim 86**, Palthenge **does not** specifically disclose prompting the data subject [consumer] for a passphrase; and authenticating the data subject [consumer] based on a passphrase stored within the database. Meyer discloses prompting the

data subject [consumer] for a passphrase; and authenticating the data subject [consumer] based on a passphrase stored within the database (see, for example, at least Col. 33, lines 23-34, Col. 39, lines 29-35).

It would have been obvious to one of ordinary skill at the time the invention was made to combine Palthenge and Meyer to specifically disclose prompting the data subject [consumer] for a passphrase; and authenticating the data subject [consumer] based on a passphrase stored within the database.

One of ordinary skill at the time the invention was made would have been motivated to combine Palthenge and Meyer to specifically disclose prompting the data subject [consumer] for a passphrase; and authenticating the data subject [consumer] based on a passphrase stored within the database for the obvious reason that consumer information may thus be protected from unauthorized use.

**As per claim 89**, Palthenge **does not** specifically disclose storing the transaction information in an authorized data recipient [merchant] transaction log. Meyer discloses storing the transaction information in an authorized data recipient [merchant] transaction log (see, for example, at least Col. 50, lines 53-27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Palthenge and Meyer to disclose storing the transaction information in an authorized data recipient [merchant] transaction log.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Palthenge and Meyer to disclose storing the transaction information in an authorized data recipient [merchant] transaction log for the obvious

reason that merchants may wish to analyze the data periodically and on a regular basis, such as for suspicious patterns.

**As per claim 90**, Palthenge does not specifically disclose storing the transaction information in a data subject [consumer] transaction log. Meyer discloses storing the transaction information in a data subject [consumer] transaction log (see, for example, at least Col. 4, lines 8-31, Col. 8, lines 11-37).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Palthenge and Meyer to disclose storing the transaction information in a data subject [consumer] transaction log.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Palthenge and Meyer to disclose storing the transaction information in a data subject [consumer] transaction log for the obvious reason that merchants may wish to analyze the data periodically and on a regular basis, such as for suspicious patterns.

**As per claim 91**, Palthenge **does not** specifically disclose sending a transaction confirmation message to the data subject [consumer]. Meyer discloses sending a transaction confirmation message to the data subject [consumer] (see, for example, at least Col. 41, lines 22-40, Col. 42, line 59-Col. 43, line 14).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Palthenge and Meyer to disclose sending a transaction confirmation message to the data subject [consumer].

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Palthenge and Meyer to disclose sending a transaction confirmation message to the data subject [consumer] for the obvious reason of letting a consumer make purchases and to assure that settlement can take place.

Claim 94 is rejected on the same grounds as claim 82.

Claim 95 is rejected on the same grounds as claim 83.

Claim 96 is rejected on the same grounds as claim 84.

Claim 97 is rejected on the same grounds as claim 85.

Claim 98 is rejected on the same grounds as claim 86.

Claim 101 is rejected on the same grounds as claim 89.

Claim 102 is rejected on the same grounds as claim 90.

Claim 103 is rejected on the same grounds as claim 91.

Claim 106 is rejected on the same grounds as claim 82.

Claim 107 is rejected on the same grounds as claim 83.

Claim 108 is rejected on the same grounds as claim 84.

Claim 109 is rejected on the same grounds as claim 85.

Claim 110 is rejected on the same grounds as claim 86.

Claim 113 is rejected on the same grounds as claim 89.

Claim 114 is rejected on the same grounds as claim 90.

Claim 115 is rejected on the same grounds as claim 91.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES ZURITA whose telephone number is (571)272-6766. The examiner can normally be reached on 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on (571)272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James Zurita/  
Primary Examiner  
Art Unit 3625  
15 March 2009